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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/635,948 | 08/07/2003 | Gregory Don Moore | 6108.73 | 1225 |

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| EXAMINER | |
|---|---|
| OMGBA, ESSAMA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3726 | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/635,948 | MOORE ET AL. | |
| | Examiner | Art Unit | |
| | Essama Omgba | 3726 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *7,11 and 16-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *11,16 and 17* is/are allowed.

6)☒ Claim(s) *7 and 18-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of JP'442 (JP 2001096442).

Applicant, at pages 1, 2 and 5 of the specification to be known as AAPA, discloses a method of recycling a whole rail comprising a lower portion, an upper portion and a web portion, wherein the rail is heated to a plastic state and slit in a plurality of pieces and the plurality of pieces are deformed to a generally uniform shape. Although AAPA does not disclose the rail being slit across a hole formed therein, however it is known to slit a rail across a hole formed therein in order to reduce the energy used in slitting the rail as attested by JP'442, see abstract and the computer on-line translation. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have slit the rail of AAPA across a hole formed therein, in light of the teachings of JP'442, in order to reduce the energy used in slitting the rail. Applicant should note that any of the plurality of pieces could be called a first piece or a second piece. Applicant should note that the rail of AAPA is considered slit across the web section since it is slit to separate the web from the lower and upper portions and is slit longitudinally.

3. Claims 18-20, 26, 47, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA.

With regards to claims 18, 26 and 47, Applicant, at pages 1, 2 and 5 of the specification to be known as AAPA, discloses a method of recycling a whole rail comprising a lower portion, an upper portion and a web portion linking the lower and upper portions, wherein the rail is slit in a plurality of pieces and the plurality of pieces are deformed to a generally uniform shape. Although AAPA does not disclose the rail being slit generally in half to separate the rail generally into a first half and a second half, however it is within the general knowledge of one of ordinary skill in the art to slit the rail in the number of pieces that would facilitate recycling. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have slit the rail of AAPA generally into a first half and a second half, as is within the general knowledge of one of ordinary skill in the art. Applicant should note that the rail of AAPA is considered slit across the web section since it is slit to separate the web from the lower and upper portions and is slit longitudinally.

For claims 19 and 49, see paragraphs 24 and 25 of the specification where it is admitted that reduction passes are conventional and are associated with slitting knives.

For claim 20, Applicant should note in as much as the method steps of AAPA are similar to the claimed method steps, it is obvious that the same results would be obtained, therefore it is expected that the rail halves of AAPA would be substantially seam-free after the step of deforming.

For claim 50, Applicant should note that deformation of the pieces in the prior art produced pieces with substantially similar shape.

4. Claims 21-25, 27-46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of JP'442.

With regards to claims 21, 22, 27, 30, 31, 35, 36, 44, 46 and 48, AAPA discloses a method of recycling a rail as shown above. Although AAPA does not disclose the rail being slit across a void or hole formed therein, however it is known to slit a rail across a void or hole formed therein in order to reduce the energy used in slitting the rail as attested by JP'442, see abstract and the computer on-line translation. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have slit the rail of AAPA across a hole formed therein, in light of the teachings of JP'442, in order to reduce the energy used in slitting the rail.

For claims 23, 25, 32, 34, 37 and 43, Applicant should note that it is inherent that slitting the rail across the void or the hole would create a notch or a partial hole in each half of the rail.

For claims 24, 33 and 38, Applicant should note that following AAPA/JP'442's method would also reduce the probability of forming structurally deficient seams in the halves of the rail.

For claim 28, see paragraphs 24 and 25 of the specification where it is admitted that reduction passes are conventional and are associated with slitting knives.

For claim 29, Applicant should note in as much as the method steps of AAPA are similar to the claimed method steps, it is obvious that the same results would be

obtained, therefore it is expected that the rail halves of AAPA would be substantially seam-free after the step of deforming.

For claim 39, Applicant should note that it is inherent that deforming the first and second halves would elongate the respective notches.

For claims 40 and 41, Applicant should note that following AAPA/JP'442's method would also reduce scrap associated with deforming the halves of the rail and increase the amount of the rail that can be recycled..

For claim 42, Applicant should note that following AAPA/JP'442's method would substantially eliminate the respective notches in the halves of the rail.

For claim 45, it is within the general knowledge to use the appropriate number of mill pass lines to recycle the rail.

### *Allowable Subject Matter*

5. Claims 11, 16 and 17 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: Applicant's arguments with regards to claim 16 are persuasive.

### *Response to Arguments*

7. Applicant's arguments filed November 11, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that neither AAPA nor JP'442 discloses or suggests slitting the rail longitudinally, the examiner respectfully disagrees: in AAPA, the

rail is slit in portions separating the head portion from the flange portion, which is also the manner contemplated by Applicant, therefore if slitting the rail longitudinally means slitting it in that manner then both AAPA and Applicant slit the rail longitudinally.

In response to Applicant's argument that JP'442 teaches fracturing a rail at a notched stress concentration point where the fracture is transverse, not longitudinal, the examiner submits that the rail of AAPA is slit longitudinally as shown above and since a hole diameter is the same whether taken vertically or horizontally, the direction in which JP'442 slits the rail is inconsequential since the same energy saving would result no matter the direction of the slit. JP'442 is used to show that when slitting a rail with a hole in it, it is preferable to slit the rail through the hole to save energy, therefore the examiner maintains that the references are properly combined.

In response to arguments relating to independent claims 18 and 27, the examiner maintains that it would have been obvious to one of ordinary skill in the art to slit the rail in as many pieces as necessary. The broadly recited steps of slitting and deforming are known in the prior art.

In view of the above remarks, the examiner maintains that a *prima facie* case of obviousness has been established in the instant application as it relates to claims 7 and 18-50.

## ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Jimenez can be reached on (571) 272-4530. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Essama Omgba
Primary Examiner
Art Unit 3726

eo
January 22, 2006